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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,903	02/14/2002	Thomas E. Coleman	1438.001US2	1907
21186	7590	11/02/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/076,903

Applicant(s)

COLEMAN, THOMAS E.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/18/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment received on 8/18/2005 is acknowledged and entered. The applicant has amended claims 1,5,12,21,24,28 and 32. Currently claims 1-34 are pending for examination.

### ***Response to Arguments***

2.1. Applicant's arguments, see Remarks, filed 8/18/2005, with respect to rejection of claims 1-2, 21-34 under 35 U.S.C. 101 have been fully considered and are persuasive. The rejection of claims 1-2, 21-34 under 35 U.S.C. 101 has been withdrawn.

2.2. Applicant's arguments filed 8/18/2005 against 102 (e) and 103 (a) rejection of claims 1-34 have been fully considered but they are not persuasive. The applicant argues that Herz does not teach (see Remarks, page 10, lines 27-28) "that the proxy server uses verified information to identify discrepancies in the purchaser-supplied information", a newly added element to all the independent claims. The examiner respectfully disagrees because Herz does teach this limitation, see col.37, line 59-col.38, line 6, wherein the proxy server uses the credentials [credentials are the verified information which can be used to validate or check or identify the user's supplied information] supplied from third parties to identify discrepancies, such as if the user is adult and the information supplied shows otherwise and thereby updating the user's new demographics. Since this argument also applies to rest of the claims the arguments presented on pages 11-13 are not found persuasive.

2.3. The applicant argues, see page 14 of the Remarks, that the applicant reserves the right to swear behind references but examiner respectfully disagrees because it should have been filed before a Final Rejection, see MPEP 715.09 SEASONABLE PRESENTATION (Affidavits).

This is a Final Rejection.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10, 12-16, 18-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Herz (US Patent 6,460,036 B1).

Regarding claims 1-4, Herz discloses a method for delivery of targeted commercial messages (see at least Abstract), comprising:

assembling a plurality of potential purchaser profiles which include purchaser supplied information and further include verified information to supplement and identify discrepancies in the purchaser supplied information for presentation to at least one potential advertiser of goods or services applicable to a substantial portion of the plurality of potential purchasers (col.37, line 59-col.38, line 6, " The structure of the user's database entry consists of a user profile as detailed herein, a target profile interest summary as detailed herein, ... At any time after database entry for Pseudonym P is established, the user U may provide proxy server S2 with credentials on that pseudonym, provided by third parties, which credentials make certain assertions about that pseudonym. The proxy server may verify those credentials and make appropriate modifications to the user's profile as required by these credentials such as recording the user's new demographic status as an adult. It may also store those credentials, so that it

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can present them to service providers on the user's behalf. ..."; Note: the proxy server uses the credentials [credentials are the verified information which can be used to validate or check or identify the user's supplied information] supplied from third parties to identify discrepancies, such as if the user is adult and the information supplied shows otherwise and thereby updating the user's new demographics.);

developing commercial message selection criteria for selecting from the potential purchasers those suited to receive a specified commercial message contained in a set of commercial messages; applying the commercial message selection criteria to the purchaser profiles to identify the potential purchasers suited to receive specified commercial messages; and presenting to a purchaser display unit of a potential purchaser identified as suited, the specified commercial messages, wherein the specified commercial message prompts interactive input at the purchaser display unit, and the method further comprises receiving from the purchaser display unit interactive input signals, wherein the act of displaying comprises selecting at the purchaser display unit the specified commercial message from a set of commercial messages. (see at least col.40, lines 16-59, which teaches developing a selection criteria by associating a target object with the weighted advertisements leading to present a selected advertisement(s)/specified commercial message(s) from a set of such advertisements and messages to the user in which he is most likely interested and then the user using his client processor C3 can interact in response to receiving the targeted advertisement). Herz also discloses that the act of displaying comprises selecting at a broadcast facility the specified commercial message from a set of commercial messages and communicating that specified commercial message to the purchaser display unit (see at least col.40, lines 16-59 which disclose that a server selects the messages to be presented and displayed to the user and this

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server corresponds to the claimed broadcasting facility). Also, please refer to following relevant excerpts: col.55, line 43-col.65, line 6 and See also, col.46, line 37-col.47, line 54.

Regarding claim 5, its limitations are closely parallel to the limitations of claim 1 and is therefore analyzed and rejected on the same basis.

Regarding claims 6-10, Herz teaches implementing act of presenting via e-mail (see at least col.62, line 64-col.63, line 19, " E-Mail Filter.....") and compensating the potential purchaser for receiving, viewing and interacting with specified commercial messages (see at least col.40, lines 50-55, "..... In return, the advertiser may transmit an electronic payment to proxy server S2; proxy server S2 retains a service fee for itself, optionally forwards a service fee to information server S4, **and the balance is forwarded to the user or used to credit the user's account on the proxy server.** ". Note: This compensation is provided to the user for receiving, viewing and interacting to the targeted advertisement sent to him. See also, col.46, line 37-col.47, line 54.).

Regarding claims 12-16, 21-22, 24-25, 28-29 and 32-33, their limitations are closely parallel to the limitations of claims 1-10 and are therefore analyzed and rejected on the same basis.

Regarding claims 18-19, 23, 26, 30 and 34 Herz teaches that the verified information includes self-verified information that is compared to the purchaser-supplied information and that the self-verified information includes behavioral information (see at least col.17, line 29-col.18, line 27 which suggests refining the purchaser supplied information with the feedback

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received from the purchaser's behavior displayed in his interactions with the specified messages presented to him.

Regarding claims 20, 27 and 31, Herz teaches presenting specified commercial messages over the data network as analyzed in claims 1, 24 and 28 above. Herz also discloses presenting content with the said messages (see at least col.40, lines 16-50 which teaches presenting advertisements [specified commercial messages along with targeted objects [ corresponds to content].

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz in view of Goldhaber et al. (US Patent 5,794,210), hereinafter, referred to Goldhaber.

With regards to claim 11, Herz teaches the limitations recited in claim 7 as analyzed above including compensating a purchaser for interacting with the specified commercial message. Herz does not suggest that compensating the potential purchaser is based on a level of profile information provided by the potential purchaser. However, Goldhaber teaches this limitation, see col.17, lines 12-63. Goldhaber teaches that depending upon the type of interaction the purchaser has with the message the compensation is provided, that is if it is good then he is allowed the compensation and if bad then the compensation button is inactivated. Thus Goldhaber, based upon the tracked profile/behavior, decides the compensation to be given or not to the purchaser. In view of Goldhaber, in the field of same

endeavor, it would have been obvious to a skilled artisan to modify Herz to incorporate Goldhaber's feature of compensating the potential purchaser based on a level of profile information provided by the potential purchaser because it would allow the advertiser to control his expenses and to ensure payment to only those purchasers who show adequate interest and spend time in perusing the advertisements/messages.

4.2. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz in view of Eldering et al. (US Patent 6,684,194), hereinafter, referred to Eldering.

With regards to claim 17, Herz teaches the limitations recited in claim 16 as analyzed above including that the verified information includes third party verified information which is compared to the purchaser-supplied information. Herz does not explicitly suggest that the third party information includes information from a database controlled by a third party. However, Eldering teaches this limitation, see col.5, lines 41-44, which teaches obtaining user's profile from a database controlled by a third party, such as a retailer or data collector. In view of Eldering, in the field of same endeavor, it would have been obvious to a skilled artisan to modify Herz to incorporate Eldering's feature that the third party information includes information from a database controlled by a third party because it would allow the advertiser/system to update the user's profile based upon his behavior while interacting with the third party website, such as retailer's and use the feedback to refine the targeted content to be displayed to the user.

#### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



US Patent 6,032,177 to O'Donnell teaches or makes it obvious assembling a plurality of potential purchaser profiles for marketing purposes and many other uses and further teaches checking for discrepancies in the respondents supplied information (see at least col.1, lines 21-35).

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

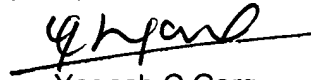
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
October 30, 2005